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10/578,378	05/05/2006	Declan Patrick Kelly	CN 030047	6604

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EXAMINER	
KIM, EDWARD J	

ART UNIT	PAPER NUMBER
2455	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/578,378	KELLY ET AL.	
	Examiner	Art Unit	
	EDWARD J. KIM	2455	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the amendment filed on 07/03/2008.

2. Claims 1-10 are pending in this office action. Claims 1-10 have been amended.

Response to Amendment

3. The Examiner accepts the amendments made to the Drawings.

4. The Examiner retains the 35 U.S.C. 112 rejections that were presented in the previous Office Action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "the abnormal playing status", which is described in the Specification as including "pause status, copyright information status (some text information used by copyright warning) and director annotation (some explanatory words used by director annotation), and the like" (refer to pg.5 ln.3-5 of the Specification of the Application filed 05/05/2006). The scope of

"abnormal playing status" limitation, which seems to be the core part of the invention, cannot be determined even in view of the Specification of the Application.

Similarly, claim 1 recites "the information required in the normal status", which is not described in the Specification in detail to determine the scope of the feature.

Appropriate correction is required and it is noted by the Examiner that the Applicant may not introduce new matter into the Application.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 6 recite "the abnormal playing status", which is described in the Specification as including "pause status, copyright information status (some text information used by copyright warning) and director annotation (some explanatory words used by director annotation), and the like" (refer to pg.5 ln.3-5 of the Specification of the Application filed 05/05/2006). The scope of "abnormal playing status" limitation, which seems to be the core part of the invention, cannot be determined even in view of the Specification of the Application. Therefore, claim 1 is vague and indefinite to what the limitation is, failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The disclosure defines the above term as pause status, copyright information status, director annotation *and the like.* These seem to suggest that any kind of interruption or operation performed during playing of data is considered to be an abnormal playing status. The metes and

bounds of the term are vague and indefinite. Pause status may be an operation carried out by a user.

Similarly, claims 1 and 6 recite "the information required in the normal status", which is not described in the Specification in detail to determine the scope of the feature, failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The metes and bounds of an abnormal playing status cannot be determined as explained above. Accordingly, metes and bounds of a normal playing status cannot be determined. The disclosure seems to suggest a normal playing status is one that plays the data without any interruption or any kind of operation performed such as pausing.

Further clarification of the two terms is required.

Regarding claim 1, it is vague and indefinite to what "information which is required to be downloaded for normal play of content" is referring to. Since the metes and bounds of the normal and abnormal playing status cannot be determined as explained above, the metes and bounds of the term cannot be determined in view of the disclosure in the specification.

9. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Also the Examiner notes that similar errors are apparent in the Specification.

Example of such error:

Refer to lines 17-21 of page 3 of the Marked-up version of the Specification filed on 07/03/2008, "...the phenomena such as playing is not smoothly, even playing is interrupted and so on can be avoided during the process of playing while downloading".

The Examiner suggests that the Applicant double-check the claims and specification for informalities in grammar, which creates confusion in understanding the claimed invention, in order to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, 5-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanazawa et al. (US Patent #6,580,870 B1), hereinafter referred to as Kanazawa.

Kanazawa discloses a system for reproducing AV information from a recording medium, which utilizes other external resources on a computer network that is referenced via URL (Kanazawa, Abastract).

Regarding claim 1, Kanazawa discloses, an optical disc player (Kanazawa, Abstract, col.1 ln.20-25, col.1 ln.57-67), comprising: a detecting module for detecting whether the player is in a normal playing status or an abnormal playing status, and sending a searching command

when the abnormal playing status being detected out (Kanazawa, col.5 ln.10-34, col.6 ln.54-60, col.8 ln.10-20);

a searching module for searching a URL list stored on an optical disc in response to the search command to identify a URL in the URL list which provides a link to information which is required to be downloaded for normal play of content of the optical disc, but which has not yet been downloaded; and (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65. Kanazawa discloses the use of external resources on a computer network.);

and a network management apparatus for accessing one or more URLs identified by the search module to download information that is required for normal play only while the player is detected to be in the abnormal playing status (Kanazawa, col.5 ln.18-34, col.6 ln.55-67, col.5 ln. 46-54.).

Regarding claim 2, Kanazawa disclosed the limitations, as described in claim 1, and further discloses, a storage for storing the downloaded information to be subsequently accessed and used for normal play when a normal playing status s subsequently detected (Kanazawa, col.5 ln.10-34, col.6 ln.43-50. Kanazawa discloses downloading external information from web pages or on a computer network it is connected to.).

Regarding claim 3, Kanazawa disclosed the limitations, as described in claim 1, and further discloses, wherein the abnormal playing status includes a pause status (Kanazawa, col.8 ln.10-20, col. 16 ln.25-40).

Regarding claim 5, Kanazawa disclosed the limitations, as described in claim 1, and further discloses, wherein the abnormal playing status includes a director annotation status (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65).

Regarding claim 6, Kanazawa discloses, a playing method of optical disc, comprising acts of:

detecting a playing status as a normal playing status or an abnormal playing status (Kanazawa, col.8 ln.10-20);

searching a URL list stored on an optical disc in response to the search command to identify a URL in the URL list which provides a link to information which is required to be downloaded for normal play of content of the optical disc, but which has not yet been downloaded, if the playing status is detected to be abnormal (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65. Kanazawa discloses the use of external resources on a computer network.);

and accessing one or more URLs identified by the searching to download the information that is required in the normal playing status only while the player is detected to be in the abnormal playing status (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65, col.6 ln.43-50. Kanazawa discloses downloading external information from web pages or on a computer network it is connected to.).

Regarding claim 7, Kanazawa disclosed the limitations, as described in claim 6, and further discloses, wherein the act of searching includes waiting until the detected playing status returns to normal if the URL of the information which is not downloaded is not searched out (Kanazawa, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.).

Regarding claim 8, Kanazawa disclosed the limitations, as described in claim 6, and further discloses, further comprising the act of stroing the downloaded information for

subsequent access and use for normal play when a normal playing status is subsequently detected (Kanazawa, col.5 ln.10-34, col.6 ln.43-50.).

Regarding claim 9, Kanazawa disclosed the limitations, as described in claim 6, and further discloses, wherein the abnormal playing status includes a pause status (Kanazawa, col.8 ln.10-20, col. 16 ln.25-40).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanazawa et al. (US Patent #6,580,870 B1), hereinafter referred to as Kanazawa, in view of "Official Notice".

Regarding claim 4, Kanazawa disclosed the limitations, as described in claim 1, and further discloses, an abnormal playing status (Kanazawa, col.7 ln.60-64), however, fails to explicitly disclose including the copyright information status.

"Official Notice" is taken by the Examiner that the verification of copyright information is well-known and common in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teachings of Kanazawa to take into account the copyright information when looking at data related to the media before playing it. One would have been motivated to do so, as copyright verification was well-known and common

in the art for ensuring protection of media rights on media players, and conforming with the law ruling copyright.

Regarding claim 10, Kanazawa disclosed the limitations, as described in claim 6, and further discloses, an abnormal playing status (Kanazawa, col.7 ln.60-64), however, fails to explicitly disclose including the copyright information status.

"Official Notice" is taken by the Examiner that the verification of copyright information is well-known and common in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teachings of Kanazawa to take into account the copyright information when looking at data related to the media before playing it. One would have been motivated to do so, as copyright verification was well-known and common in the art for ensuring protection of media rights on media players, and conforming with the law ruling copyright.

Response to Arguments

14. Applicant's arguments filed on 07/03/2008 have been fully considered but they are not persuasive.

15. The Examiner has previously noted in the Conclusion section,

> **"Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner."

16. The Applicant argues,

> "In this regard, it I respectfully submitted that Kanazawa does not teach or suggest the present invention as recited in independent claims 1 and 6. For example, there is nothing in the above cited sections of Kanazawa or otherwise which teaches or suggests, for example, searching a URL list stored on an optical disc in response to a search command (which is issued when an abnormal playback status is detected) to identify a URL in the URL list which provides a link to information which is required to be downloaded for normal play of the content of the optical disc, but which has not yet been downloaded, as essentially recited in claims 1 and 6.
>
> Moreover, there is nothing in the above cited sections of Kanazawa or otherwise which teaches or suggests, for example, accessing one or more URLs identified by the search module to download information that is required for normal play only while the player is detected to be in the abnormal playing status, as essentially recited in claims 1 and 6." (refer to pg.16-17 of the Amendment filed on 07/03/2008)

The Examiner respectfully disagrees.

As agreed by the Applicant, Kanzawa discloses that at the beginning of a playback process and during the playback process, the CPU reads the information management table (which contains resource use information for using resources for identifying streams in the title information and access link information), and uses the information to display a Web Mark in the display section (refer to pg.15-16 of the Amendment filed 07/03/2008). Moreover, Kanazawa discloses a usage scenario wherein a Web page content associated with the content is downloaded for display on the screen after the *playback is suspended* by the user's clicking on a Web mark (refer to last paragraph of pg.17 of the Amendment filed on 07/03/2008).

As explained in the 35 U.S.C. 112 rejections in the previous and present Office Action, the metes and bounds of the terms, "abnormal playing status" and "normal playing status" cannot be clearly determined. As taught by Kanazawa and agreed by the Applicant (shown above), the information referenced by the URL is searched and downloaded when the system is in an abnormal playing status (paused/suspended by the user). The content is first downloaded, then

shown to the user in the display section. The content is suspended until this operation is performed. This is one example of the system disclosed by Kanazawa.

The Examiner also points out another example of *downloading information that is required for normal playing of the content* in columns 5 and 6 of Kanzawa. Kanazawa discloses that parental information is required to be searched, downloaded, and compared prior to normal play of the content.

For at least the above reasons, the Examiner respectfully disagrees with the Applicant's argument. Kanazawa discloses that "the link information that is required for normal playback is downloaded in advance of its use only during periods of abnormal playback status" (refer to first few lines of pg.18 of the Amendment filed on 07/03/2008).

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWARD J. KIM whose telephone number is (571)270-3228. The examiner can normally be reached on Monday - Friday 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Edward J Kim/
Examiner, Art Unit 2455

/saleh najjar/
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